

REMARKS

In the Official Action mailed on October 5, 2004, the Examiner rejected claims 1 – 7, 9 – 14, and 16 – 20. The Examiner objected to claims 8 and 15.

With regard to United States Patent 5,232,387 (Sumigawa) patent, the Examiner states that the Sumigawa patent does not show a polymer sump. Applicants agree with this assessment.

With regard to United States Patent 4,280,453 (List et al.), the Examiner refers to a comment in column 2 which, in applicants' opinion, appears to be an appraisal made by the inventors of the List et al. invention about a characteristic of another patent. In the portion identified between lines 38 and 41 of column 2 in the List et al. patent, and particularly the sentence on lines 40 and 41, it states that, "For this reason it is not a casting but made of sheet metal or plastics material."

Applicants respectfully point out for Examiner's consideration that this comment, cited above, concerns U.S. Patent 3,464,398, which issued to Scheiterlein et al. Applicants acknowledge that both of these patents are owned by a common assignee. However, a careful review of the Scheiterlein et al. patent does not specifically disclose the material used to construct either the oil pan 18 or the oil reservoir 30. The material is described, in the Scheiterlein et al. patent, as having "soundproofing" characteristics, but is neither described as a polymer material nor a plastic material. The only such descriptive comment is the indirect mention of the alternative possibility, stated in the List et al. patent, that the material is not a casting but can be made of sheet metal "or plastics material." Applicants respectfully contend that this type of indirect reference, where a sentence in the List et al. patent is used to bestow a possible attribute to the device in the Scheiterlein et al. patent, is improper.

Notwithstanding the indirect inference relating to the List et al. and Scheiterlein et al. patents, applicants also vigorously contend that both the Sumigawa and List et al. patents clearly teach away from the subject invention and, even if the Scheiterlein et al. patent is combined with these two cited references, the three patents each teach away from the subject invention in significant ways.

Although the Sumigawa patent does not explicitly describe the type of metal material used to manufacture the oil pan 30, it makes other comments that clearly imply that this structure

is metallic and not polymeric. For example, in the paragraph that begins at line 20 of column 6, the Sumigawa patent states:

“In this embodiment the exhaust pipe 40 and the oil pan 30 are formed as an integral structure.” (Emphasis added)

If the oil pan 30 is not metallic, the above cited comment would require that the exhaust pipe 40 be made of a polymer or plastic material. Applicants respectfully suggest that this is unlikely. In the paragraph that begins at line 11 of column 7, the Sumigawa patent states:

“Since fresh coolant water is constantly circulated throughout the upper casing 16 during operation of the engine, in the embodiment of Figure 9, the temperature within the upper casing 16 is maintained at a relatively low level. Thus, the problems of excessive heating of the lubricant within the oil pan 30 and corrosion of the oil pan 30 from crystallized salts on its outer surface are avoided.” (Emphasis added)

The steps taken to avoid corrosion of the oil pan 30, as described in the cited portion above, clearly imply that the oil pan 30 is made of a material that is subject to corrosion. This, in turn, clearly implies that the material is not a polymer.

In view of these two citations from the Sumigawa patent, applicants respectfully contend that the Sumigawa patent teaches that the oil pan 30 is made of a metal. As a result, it teaches directly away from a polymer containment, used as an oil sump, disposed within the outer containment. Therefore, although the Sumigawa patent teaches one container 30 disposed within another container 16, it clearly teaches away from the concept that the inner container can be a polymer material.

With regard to the List et al. patent, it neither teaches nor suggests the use of one container disposed within another container. By avoiding the necessity of nesting containers in this manner, it clearly teaches away from the concept of using a second containment disposed within a first containment. Neither the List et al. patent nor the Scheiterlein et al. patent recognizes any need whatsoever to provide a surrounding plenum around the outer surface of an inner containment or oil sump. Therefore, these patents do not teach or suggest this nesting concept relating to two containers. In fact, by avoiding the need for nested containers, these two patents both teach away from that concept. Neither patent recognizes any benefit from the nesting configuration or any combination with the teaching of the Sumigawa patent.

Applicants respectfully contend that Examiner has cited two patents which each directly teach away from the concept of the subject invention and then the Examiner has suggested that a combination of these two patents would make the subject invention obvious. Neither the Sumigawa nor the List et al. patent teaches or suggests any need for combination with the other patent. The Sumigawa patent apparently provides one metallic container within another metallic container and makes no comment about any advantage that could be obtained by replacing the inner metallic container with an inner polymer container. The List et al. patent, in its indirect comment about the Scheiterlein et al. patent, raises the possibility that the oil pan in the Scheiterlein et al. patent may be non-metallic. However, the existence of the oil pan, with no nested containment around it or within it, clearly shows that a nested arrangement is not required nor suggested by the List et al. or Scheiterlein et al. patents.

In view of the above, applicants respectfully contend that the combination of the Sumigawa and List et al. patents is improper because neither of these two references suggest a benefit that could be obtained by combination with the other. In addition, each of these two references clearly teach away from such a combination. The Sumigawa patent teaches a metallic container that would have to be removed from the structure and be replaced by a non-metallic container for no apparent reason. On the other hand, a change in the List et al. structure would require an outer containment being disposed around the oil pan which appears to function satisfactorily without any nested container.

In view of the above, applicants respectfully contend that the combination of the Sumigawa and List et al. patents is improper and the rejection of the claims of the subject patent application based on this unsupported combination of references, should be withdrawn.

Applicant intends to provide formal drawings after receipt of the Notice of Allowance to replace the originally filed drawings which, although determined by the Examiner to be suitable for prosecution, are informal.

In view of the above discussion, applicants respectfully request Examiner's reconsideration of the subject patent application and expeditious allowance of claims 1 – 20.

Respectfully Submitted,



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